

REMARKS

Claims 1, 17-22 and 27-30 are all the claims pending in the application.

Claims 1, 17, 18, 21, 22 and 27 have been rejected under 35 U.S.C. § 102(b) as anticipated by the newly-cited JP 07-230811.

Applicants submit that JP '811 does not disclose the subject matter of the above claims and, accordingly, request withdrawal of this rejection.

The Examiner has supplied a computer translation of JP '811, and refers to various portions of the computer translation in support of his position.

As can be seen from the computer translation, JP '811 does not disclose the recitation in independent claims 1, 17, 21 and 22 of a fiber filament diameter of 100 to 300 nm.

The Examiner recognizes that JP '811 does not disclose a fiber filament diameter range of 100 to 300 nm, but asserts that JP '811 discloses a fiber filament diameter of 0.3 to 0.6 micrometers, which corresponds to 300 to 600 nm. The Examiner argues that the lower limit of 300 nm is a specific data point that is identical to the endpoint of the present claims, and since the specific data points are identical, that JP '811 therefore anticipates the present claims.

Although the Examiner is correct that the endpoint of 300 nm of the present claims is the same as the lower endpoint of 0.3 micrometers disclosed in JP '811, applicants submit that the Examiner's legal analysis is flawed because the case law makes it clear that the disclosure in the prior art of an endpoint of a range is not a disclosure of that endpoint. See *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991 (Fed. Cir. 2006). *Atofina* also makes it clear that a range of 300 to 600 nm is not the same as a range of 100 to 300 nm. In view of the *Atofina* decision,

applicants submit that it is clear that the disclosure of a range of 300 to 600 nm in JP '811 does not anticipate the range of 100 to 300 nm set forth in the present claims.

In view of the above, applicants submit that JP '811 does not anticipate the present claims and, accordingly, requests withdrawal of this rejection.

Claims 1, 17, 18, 21, 22 and 27 have been rejected under 35 U.S.C. § 103(a) as obvious over JP '811.

This rejection is essentially identical to the rejection above, except that the Examiner asserts that, even if the range of 300 to 600 nm disclosed in JP '811 does not anticipate the present claims, the differences between the two claimed ranges is considered to be a slight difference which is obvious to one of ordinary skill in the art.

In support of his assertion that the difference is obvious, the Examiner, beginning at the bottom of page 8 of the Office Action, points out that the present specification at page 19, lines 11-22, discloses that acceptable diameters can be from 500 nm or less. The Examiner states that, therefore, there is no apparent critical or patentable distinction for the claimed range of 100 to 300 nm diameter values as compared to diameters of up to 500 nm. The Examiner states that with this understanding, the prior art teachings in JP '811 exhibit a significant overlap with the overall recognized acceptable fiber diameters, and that there is no evidence of critical and unexpected results associated with the claimed range of 100 to 300 nm as compared to the values up to about 500 nm.

The Examiner, therefore, states that the prior art teaching of fiber diameters of 300 to 600 nm are considered to be slightly different from the claimed range, but would be appreciated as being acceptable diameters. The Examiner further states that, generally, differences in ranges

will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating that such range is critical. The Examiner then cites a number of decisions in support of his statement.

Applicants submit that the above analysis of the Examiner is flawed because it relies on the teachings of the present specification to show an equivalence between diameters of up to 500 nm and diameters of 100 to 300 nm. The case law is clear that an Examiner cannot rely on the disclosure in an applicant's specification to establish equivalence. Accordingly, applicants submit that the Examiner's analysis is not correct.

Further, as disclosed in the present specification at page 12, last paragraph, "VGCF having a fiber filament diameter of more than 300 nm is not satisfactorily entangled with particles of a catalyst for a cell, from the viewpoint of the size and shape of the catalyst particles. Therefore, even when the VGCF is incorporated, the effect of the VGCF on conductivity is difficult to obtain."

In view of the above, applicants submit that JP '811 does not disclose or render obvious the subject matter of the above claims and, accordingly, request withdrawal of this rejection.

Claims 19 and 20 have been rejected under 35 U.S.C. § 103(a) as obvious over JP '811 and further in view of U.S. Patent 5,861,222 to Fischer et al.

Claims 19 and 20 are dependent claims that ultimately depend from claim 17. Accordingly, applicants submit that claims 19 and 20 are patentable over JP '811 for the same reasons as discussed above in connection with claim 17. Thus, claims 19 and 20 recite a diameter of 100 to 300 nm that is not disclosed or suggested by JP '811. Further, Fischer et al do not disclose or suggest such a range.

In view of the above, applicants request withdrawal of this rejection.

Claim 29 has been rejected under 35 U.S.C. § 103(a) as obvious over JP '811 in view of the admitted prior art that is disclosed in the present application, especially Figure 1.

The Examiner states that the difference between the presently claimed invention as set forth in claim 29 and JP '811 is that JP '811 does not appear to clearly disclose providing separators to sandwich the assembly.

The Examiner argues that applicants have admitted in their discussion of Figure 1 that a typical fuel cell contains separator plates which sandwich a membrane-electrode assembly as set forth in claim 29.

Claim 29 is an independent claim that recites a fiber filament diameter of 100 to 300 nm. As discussed above, applicants submit that JP '811 does not disclose or suggest such a range.

In view of the above, applicants submit that JP '811 does not disclose or suggest the subject matter of claims 29 and, accordingly, request withdrawal of this rejection.

Claims 29 and 30 have been rejected under 35 U.S.C. § 103(a) as obvious over JP '811 in view of the newly-cited U.S. Patent 6,329,092 to Maeda et al.

In this rejection, the Examiner states at page 18 of the Office Action that the differences between the claimed invention and JP '811 is that JP '811 does not appear to clearly disclose the providing of separators to sandwich the assembly as set forth in claim 29 and does not appear to disclose a fuel battery comprising at least two fuel cells layered together as set forth in claim 30.

The Examiner relies on Maeda et al to show these features.

Claim 29 is an independent claim that recites a fiber filament diameter of 100 to 300 nm. As discussed above, JP '811 does not disclose or suggest such a range. Accordingly, applicants submit that JP '811 and Maeda et al do not render obvious the subject matter of claims 29 and 30.

In view of the above, applicants submit that claims 29 and 30 are patentable over JP '811 and Maeda et al and, accordingly, request withdrawal of this rejection.

Claim 28 has been rejected under 35 U.S.C. § 103(a) as obvious over the newly-cited JP '818 in view of the newly-cited JP '811.

The Examiner asserts that JP '811 discloses all of the features of claim 28, except that JP '818 does not teach the particulars of the claimed fibrous carbon. The Examiner relies on JP '811 to show the use of a fibrous carbons as set forth in claim 28.

Thus, the Examiner relies on JP '811 to show a fibrous carbon having a fiber filament diameter of 300 to 600 nm which, according to the Examiner, anticipates or at least renders obvious the presently claimed range of 100 to 300 nm. As discussed above, applicants submit that JP '811 does not disclose or suggest the claimed fiber diameter range.

In view of the above, applicants submit that the combination of JP '818 and JP '811 does not disclose or suggest the subject matter of claim 29 and, accordingly, request withdrawal of this rejection.

In Paragraph 9, beginning at page 23 of the Office Action, the Examiner sets forth various comments in response to the arguments that applicants previously submitted. The

Examiner states that these arguments are considered to be moot in view of the new grounds of rejection.

The Examiner states, however, that applicants' arguments were not entirely persuasive with respect to the previously cited, but no longer applied, U.S. Patent 6,780,388 to Masuko et al.

If the Examiner believes that Masuko et al is still relevant, then he should not have withdrawn the rejection and should have continued the rejection.

With respect to applicants' attempt to disqualify the Masuko et al reference, the Examiner states that applicants' statement to disqualify was not presented in a proper format. The Examiner asserts that disqualification of a 102(c) reference must be presented in the form of an appropriate affidavit or declaration.

The disqualification statement applicants submitted related to the use of Masuko et al in an obviousness rejection under 35 U.S.C. § 103(a) and was not used to disqualify Masuko et al with respect to 35 U.S.C. § 102(e). Accordingly, applicants submit the disqualification statement was appropriate.

The Examiner further states that he does not understand why applicants attempted to overcome the WO '151 reference. Applicants submit that it was appropriate to overcome this reference because WO '151 has a publication date that is earlier than the international filing date of the present application.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

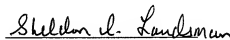
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